

**REMARKS**

The Examiner again rejected Claims 6-10 under 35 U.S.C. §112 as being indefinite. The Examiner states:

"In claim 6, the term "offsetting" is vague, thus indefinite for failing to clearly define the "offsetting" of which element(s)."

Claim 6 now has been amended to state:

a distance of said connection from said opening being ~~small enough~~ sufficient that said destructible layer is secured against any substantial offsetting to uncover said wall opening or said reinforcing part hole and that an uncovering of said opening covered by said destructible layer by contact of said destructible layer with said connection is excluded

The offsetting is directed to the destructible layer, so that the opening is not uncovered. This is now clearly set forth in amended Claim 6 and conforms with the discussion of the connection 18 on page 11, lines 4-23, especially lines 21-23. The above recited amendment to Claim 6 should obviate the 35 U.S.C. §112 indefinite rejection.

The Examiner also again rejected Claims 6-10 under 35 U.S.C. §102 as being anticipated by Jenkins. The Examiner states:

"Jenkins et al discloses a refrigerating appliance comprising all the elements recited in the above listed claims including, such as shown in Figs 5-6, a

foam-filled hollow body having a wall 27 including an opening 50 formed therein, a reinforcing bar 16 having a hole 55 formed therein and disposed with said hole overlapping said opening 50 of the wall 27, a destructible layer 48 disposed between said wall 27 and said reinforcing part 16, said wall 27 and said reinforcing part 16 being connected to each other by a connection 60 (wherein the connection point being defined as one of the two openings 50 shown in Fig 3), wherein said connection extends through said destructible layer 48, and said connection is a rivet connection, said opening 50 is disposed on a front side of said housing and is provided for mounting a hinge (col. 6, lines 56-61)."

The Examiner further states:

"Applicant's arguments filed 7/11/2005 have been fully considered but they are not persuasive. In response to applicant's argument on page 7 that "these preformed opening in the metal strips cannot be the claimed "destructible layer" which is formed to cover the openings and is so claimed", the examiner takes the position that Office action never stated that the openings in the metal strips/destructible layer being the claimed "destructible layer", and the claimed language fails to clearly point out that the destructible layer covers the openings."

The Examiner now states that the openings in the metal mounting bars are not the "destructible layer" and that

Claim 6 does not "clearly point out that the destructible layer covers the openings." Claim 6 also now has been amended to state:

a destructible layer disposed between said wall and said reinforcing part, said destructible layer covering said wall opening and said reinforcing part hole

Claim 6 now clearly does support the argument made in response to the Examiner's rejection in the first Office Action, which as stated above the Examiner repeats in the current Office Action. As Applicants stated in the first response:

In contrast with the Examiner's statement, the "support bars 48 ... are a strong metal strip" col. 4, lines 20, 21 which "are formed with vertically spaced pairs of openings 52 and 53 which are spaced to align with openings 50 and 51" col. 4, lines 35-38 in the wall portions 27. Clearly, these preformed openings in the metal strips cannot be the claimed "destructible layer" which is formed to cover the openings and is so claimed.

Reconsideration of Claims 6-10 respectfully again is requested, since Claims 6-10 now even more clearly cover structure not disclosed or suggested the metal bars of

Jenkins or the other references of record and Claims 6-10 should clearly be allowable thereover.

Should the Examiner wish to change the current 35 U.S.C. §102 rejection of Claims 1-6 as being anticipated by Jenkins to a 35 U.S.C. §10 rejection of Claims 1-6 as being obvious over Jenkins, the Examiner should note the following arguments. Jenkins does "not teach the claimed "destructible layer" which is formed to cover the openings" as now clearly claimed and in fact Jenkins is directed to the elongated bars 48 merely being utilized as structural support against the expansion of the walls by the foaming insulation.

Clearly Jenkins make no suggestion of any destructive layer formed over the holes to prevent foaming as the structure of Jenkins includes aligned holes for the fasteners 56.

It is well settled that almost all claimed inventions are but novel combinations of old features. The courts have held in this context, however, that when "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation **in the prior art** to make the selection made by the applicant". Interconnect

Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined **only** if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be '**clear and particular.**'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000).

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ

972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), cert. den., 488 U.S. 825 (1988).

Applicant respectfully believes that any teaching, suggestion, or incentive possibly derived from the Jenkins or the other prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps. . . . The references **themselves** must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references. In fact, no support, justification, rationale, or reason is given to make such a conclusion.

A critical step in analyzing the patentability of claims pursuant to 35 U.S.C. § 103 is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. See In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614,1617 (Fed. Cir. 1999). Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher." Id. (quoting W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983)).

Most if not all inventions arise from a combination of old elements. See In re Rouffet, 149 F.3d 1350, 1357, 47 USPQ2d 1453,1457 (Fed. Cir. 1998). Thus, every element of a claimed invention may often be found in the prior art. See id. However, **identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention.** See id. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some

motivation, suggestion or teaching of the desirability of making the specific combination that was made by the appellant. See In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 163.5, 1637 (Fed. Cir. 1998); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

The motivation, suggestion or teaching may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or, in some cases the nature of the problem to be solved. See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. In addition, the teaching, motivation or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. See WMS Gaming, Inc. v. International Game Tech., 184 F.3d 1339, 1355, 51 USPQ2d 1385, 1397 (Fed. Cir. 1999). The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. See In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981) (and cases cited therein). **Whether the examiner relies on an express or an implicit showing, the examiner must provide particular findings related thereto.** See In re Dembiczak, 175 F.3d at 999, 50 USPQ2d



at 1617. **Broad conclusory statements standing alone are not "evidence."** Id. When an Examiner relies on general knowledge to negate patentability, **that knowledge must be articulated and placed on the record.** See In re Lee, 277 F-3d 1338, 1342-45, 61 USPQ2d 1430, 1433-35 (Fed. Cir. 2002).

No such support has been placed on the record by the Examiner, therefore independent Claim 6, as well as dependent Claims 7-10, clearly are allowable over Jenkins and the other recited references.

Claims 1-5 stand withdrawn and Claims 6-10 remain in the application and should be allowable.

If the Examiner has any questions or further objections regarding the claims, the Examiner is requested to contact the undersigned.

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Respectfully submitted



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